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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/659,473 09/11/00 WHITLAM

D 2152-PAT

EXAMINER

QM32/1003

DONN K HARMS
4565 RUFFNER STREET
SUITE 200
SAN DIEGO CA 92111

PASSANITILS

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/659,473

Applicant(s)

WHITLAM

Examiner
SEBASTIANO PASSANITI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 11, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

S. Passaniti
Sebastiano Passaniti
Primary Examiner

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This Office action is responsive to communication received 09/11/2000 - application papers filed.

Claims 1-13 are pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney ('950) in view of Ruvang, Solheim, and Nelson. The patent to Finney discloses the invention substantially as claimed. Finney, however, lacks a hosel opening having an edge lying substantially parallel with the top surface and a hosel positioned forward of the face. Nelson shows an arrangement wherein the hosel opening includes a generally planar edge that is parallel to a plane containing the top of the head, within which the shaft is fitted (Figure 8). Ruvang shows a similar arrangement wherein the orientation of the upper hosel opening may be changed via the fastener and hole expedient (elements 54 and 82). The Ruvang device is quite capable of positioning the upper hosel opening in a plane parallel with a plane containing the upper surface of the head. Nelson further shows it to be old to position the shaft forward of the plane containing the face for enhanced alignment purposes (col. 3, lines 28-45). A similar forward positioning of the hosel/shaft combination is highlighted by Solheim to provide stabilization to the head (col. 6,

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lines 1-14 and Figure 2). In view of the patents to Nelson and Ruvang, it would have been obvious to modify the device in the cited art reference to Finney by aligning the upper hosel opening in a plane parallel to a plane containing the upper surface of the head, the motivation being to help maintain a proper shaft orientation. In view of the patents to Nelson and Solheim, positioning the hosel forward of the face would have been obvious, the motivation being to gain further stability in the head. As for the remaining limitations in the claims and with respect to the % thickness of the heel, toe, and central regions as well as the weight of the insert and ends of the putter and the dimensional constraints required by the claims, the limitations are not deemed critical. The specification does not detail the significance of these limitations. Rather, the specification merely labels these limitations on thickness and weight as "preferred". To have modeled the Finney device to include any arrangement of weight among the various club head elements and/or to slightly alter the thickness of the heel, toe, or central elements in order to tailor the mass of the head would have been obvious to the skilled artisan, as it is not seen how the claimed requirements present any new or unobvious results over the arrangement shown in Finney. Note that Finney provides for the inclusion or absence of the extended sole (66), which in this case serves as the claimed insert (col. 17, lines 50-66). It is further noted that the parent application to the cited Finney reference and incorporated herein by reference recognizes the ability of the skilled artisan to vary the mass and dimensions of the club based upon its environment of use, with clubs adapted for children modeled slightly differently than those patterned for use by adults (See U.S. Pat. No. 4,984,799, col. 23, lines 20-31).

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Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney ('950) in view of Ruvang, Solheim, Nelson, and Sahm. Finney in view of Ruvang, Solheim, and Nelson has been discussed above. Finney, as modified, lacks plural diverse materials for each of the insert and the club head body. It has been previously noted herein above that Finney contemplates the addition or subtraction of the extended sole (66) which, as previously mentioned above, serves as the claimed insert. With that in mind and considering that Finney goes to great extent to explain that the weight and dimensions of the head may be changed as needed, it is clear that the skilled artisan would be motivated to incorporate elements of varying density to desirably change the weight distribution of the head. Clearly, the selection of the specific materials is not deemed novel or unobvious, as the skilled artisan would have had at the time the invention was made at his disposal a number of materials from which to select the specific materials that best tailor the weight of the head. Sahm is cited here as an example wherein a putter body includes weights of varying density to customize the weight of the head (Abstract, Figure 8, col. 6, lines 38-45). In view of the above reasoning and the patent to Sahm, it would have been obvious to modify the device in the cited art reference to Finney by making use of materials including stainless steel and aluminum for the body and insert, respectively, the motivation being to tailor the weight to fit the individual needs of a golfer.

Claims 6, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney ('950) in view of Ruvang, Solheim, Nelson, and Fenton. Finney in view of Ruvang, Solheim, and Nelson has been discussed above. With respect to a substantial portion of claim 9 and all of

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claim 11, reference is made to the rejection supra wherein all of the details regarding the insert, hosel orientation, thicknesses of the various club head parts and weight of the head are discussed. Finney, as modified, lacks at least one recess in the neck. Fenton shows a plurality of slots (112) in the hosel which serve to redistribute the weight of the head as desired (col. 3, lines 10-50). In view of the patent to Fenton, it would have been obvious to modify the device in the cited art reference to Finney by introducing at least one recess in the hosel, the motivation being to selectively weight the club head.

Claims 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney ('950) in view of Ruvang, Solheim, Nelson, Fenton, and Sahm. Finney in view of Ruvang, Solheim, Fenton, and Nelson has been discussed above. Finney, as modified, lacks plural diverse materials for each of the insert and the club head body. It has been previously noted herein above that Finney contemplates the addition or subtraction of the extended sole (66) which, as previously mentioned above, serves as the claimed insert. With that in mind and considering that Finney goes to great extent to explain that the weight and dimensions of the head may be changed as needed, it is clear that the skilled artisan would be motivated to incorporate elements of varying density to desirably change the weight distribution of the head. Clearly, the selection of the specific materials is not deemed novel or unobvious, as the skilled artisan has would have had at the time the invention was made at his disposal a number of materials from which to select the specific materials that best tailor the weight of the head. Sahm is cited here as an example wherein a putter body includes weights of varying density to customize the weight of the head

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(Abstract, Figure 8, col. 6, lines 38-45). In view of the above reasoning and the patent to Sahm, it would have been obvious to modify the device in the cited art reference to Finney by making use of materials including stainless steel and aluminum for the body and insert, respectively, the motivation being to tailor the weight to fit the individual needs of a golfer.

Claims 1, 7, 8, and 9 are objected to because of the following informalities:

As to claim 1, line 16, after "20%", the phrase --of the-- should be inserted and a semicolon (;) should follow "regions".

As to claim 7, line 1, "heal" should read --heel-- ;

As to claim 8, line 1, "heal" should read --heel-- ;

As to claim 9, line 19, after "three", the term --times-- should be inserted.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "such as" in line 3 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See ^{MPER}MEP, § 2173.05(d).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rife, Holladay, Lu, and Chavez show interchangeable weights of interest. Note the slots in the hosel in Cash. Stevenson shows sole (8A) of interest.

SP
09-27-01

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is (703)308-1006.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-1310. The formal fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579. The informal fax phone number is (703) 308-7768. Applicant is strongly urged to contact or leave voice mail notification with the examiner just prior to sending an informal facsimile transmission.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Applicant may find it useful to refer to the Official Web site for the United States Patent & Trademark Office at www.uspto.gov for information regarding a variety of patent and trademark related topics.

Sebastiano Passaniti/ sp
September 27, 2001


SEBASTIANO PASSANITI
PRIMARY EXAMINER
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